

REMARKS

The Final Office Action mailed February 25, 2003 has been received and reviewed. Claims 1-17 are currently pending in the application and all claims stand rejected. Applicants respectfully traverse the rejections as set forth herein. Reconsideration is respectfully requested.

Claim Interpretation

Independent claims 1, 6 and 11 are Jepson-type claims in accordance with 37 C.F.R. 1.75(e). Applicant respectfully submits that the Office is misconstruing the scope of claims 1, 6 and 11. The Office Action states “the preamble elements in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e) are impliedly admitted to be old in the art. Applicant even admits on page 2, lines 11-13 that ‘[t]he use of boarding bridges for facilitating the movement of passengers and cargo from a terminal building to an aircraft parked proximate thereto is well known.’ ... Therefore, the Jepson-type format used in claims 1, 6, and 11 is considered part of the admitted prior art.” (Final Office Action mailed February 25, 2003, page 8).

However, applicants respectfully submit that the elements in the preamble of a Jepson-type claim are also elements of the claimed invention even if they are part of the prior art. As stated by the Federal Circuit, in a Jepson-type claim “the claim preamble defines not only the context of the claimed invention, but also its scope.” (*Rowe v. Dror*, 112 F.3d 473, 479, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997)). Thus, “the claimed invention consists of the preamble in combination with the improvement.” (*Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 772 (Fed. Cir. 1985)). Accordingly, since “the preamble is a limitation in a Jepson-type claim,” the elements in the preamble of claims 1, 6 and 11 are also structural elements of the claimed invention. (*Epcon Gas Systems, Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1029, 61 USPQ2d 1470, 1477 (Fed. Cir. 2002)).

Therefore, the portion of claim 1 reciting “a boarding bridge, a passageway which defines a pathway for travel between an aircraft terminal and a docked aircraft” is an element of claim 1. Similarly, the portion of claim 6 reciting a “passageway for placement between an aircraft terminal and an aircraft for interconnecting said aircraft terminal with said aircraft” is an element of claim 6. Further, the portion of claim 11 stating a “passageway for placement between an

aircraft terminal and an aircraft for interconnecting said aircraft terminal with said aircraft, said passageway comprised of a plurality of passageway modules” is an element of claim 11.

Rejections under 35 U.S.C. § 103

As an initial matter, applicant respectfully submits that the obviousness rejections set forth in the Final Office Action were directed at the specific elements of the improvements of the claimed passageway, and not at the improved passageway of the preamble in combination with the improvement. “When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole.” (M.P.E.P. § 2141.01). Therefore, the elements recited in the preamble of the pending Jepson-type claims must be addressed in addition to the elements of the improvement in rendering a patentability determination. To establish a *prima facie* case of obviousness, the elements of the preamble must be combined or modified with the various elements of the improvement.

Claim 1

Claim 1 stands rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Veenema in view of Auer. Applicant respectfully traverses the rejections as hereinafter set forth.

A *prima facie* case of obviousness cannot be established for claim 1 since the cited references do not teach or suggest each and every element of claim 1. As previously discussed herein with regard to claim construction, the elements in the preamble of claim 1 are elements of the claimed invention and, therefore, to establish obviousness the cited references must teach or suggest all of the elements of the claimed invention including “a boarding bridge, a passageway which defines a pathway for travel between an aircraft terminal and a docked aircraft.” However, neither Veenema nor Auer teach or suggest a passageway which defines a pathway for travel between an aircraft terminal and a docked aircraft as required to establish a *prima facie* case of obviousness.

Further, the cited references do not include a suggestion or motivation to modify or combine the reference teachings to arrive at the claimed invention. In response the Applicant’s arguments, the Office Action indicates “when the front and rear panels function as a door by

sliding between the flanges of the vertical rails, the entire container of Veenema qualifies as a 'passageway', since it is 'a way that allows passage.'" (Final Office Action, at page 9). However, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (M.P.E.P. § 2143.01, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original)). Therefore, since the cited references do not suggest or motivate modifying the container to be configured as a passageway or modifying the container as a boarding bridge, a *prima facie* case of obviousness cannot be established.

Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 1 are requested.

Claims 2-5

Claims 2-5 stand rejected as assertedly being unpatentable over Veenema and Auer as applied to claim 1, and further in view of De Zen. Applicant respectfully traverses the rejections as hereinafter set forth.

Claims 2-5 are non-obvious, at the very least, as depending from non-obvious independent claim 1. (*See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Reconsideration and withdrawal of the obviousness rejections of claims 2-5 are, thus, requested.

Claims 6-17

Claims 6-17 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Veenema and Auer, and further in view of De Zen. Applicant respectfully traverses the rejections as hereinafter set forth.

A *prima facie* case of obviousness cannot be established with regard to independent claims 6 and 11 since the cited references do not teach or suggest each and every element of independent claim 6 or independent claim 11. Claim 6 is directed to "a passageway for placement between an aircraft terminal and an aircraft for interconnecting said aircraft terminal with said aircraft, wherein the improvement in said passageway comprises: a plurality of

passageway modules.” Claim 11 recites in part a “passageway for placement between an aircraft terminal and an aircraft for interconnecting said aircraft terminal with said aircraft, said passageway comprised of a plurality of passageway modules.” The cited references do not teach or suggest a passageway for placement between an aircraft terminal and an aircraft as required by independent claims 6 or 11 in order to establish a *prima facie* case of obviousness.

The Final Office Action indicates “[w]ith respect to the recitations in lines 4-6, 7-9, and 10-13, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation.” (Final Office Action at page 6, citing *Ex parte Masham*, 2 USPQ2d 1647 (1987)). However, the claim at issue in *Ex parte Masham* was not a Jepson-style claim, rather the preamble of the claim recited “[a]n apparatus for mixing flowing developer material.” (*Ex parte Masham* at 1647). Further, claims 6 and 11 are not intended to be used as a passageway, rather claims 6 and 11 actually **claim** a passageway. Also, neither the container of Veenema nor the extruded structural system of Auer, alone or in combination, satisfies the claimed structural limitations of claim 6 or 11.

A *prima facie* case of obviousness also cannot be established since the cited references do not suggest or motivate a modification or combination of the teachings of the cited references. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original)). In fact, neither Veenema nor Auer, alone or in combination, even mentions the terms “passage” or “aircraft.” Therefore, since the cited references do not suggest or motivate a passageway between an aircraft terminal and an aircraft including the structural limitations of claim 6 or 11, a *prima facie* case of obviousness cannot be established.

Claims 7-10 are non-obvious, at the very least, as depending from non-obvious independent claim 6 and claims 12-17 are non-obvious, at the very least, as depending from non-obvious independent claim 11.

Accordingly, reconsideration and withdrawal of the obviousness rejections of independent claims 6-17 are requested.

CONCLUSION

In view of the remarks herein, applicants respectfully submit the claims define patentable subject matter. In any questions remain after consideration of the foregoing, the Office is kindly requested to contact applicant's attorney at the address or telephone number given herein.

Respectfully submitted,



Andrew F. Nilles
Registration No. 47,825
Attorney for Applicant
TRASKBRITT, PC
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: July 25, 2003
AFN/afn
Document in ProLaw